

**REMARKS**

Claims 1, 3-5, 7-11, 13-15 and 17-20 are pending in this application. Claims 1 and 11 are independent claims. By this Amendment, claims 6 and 16 are cancelled without prejudice or disclaimer. Claims 1 and 11 are amended. No new matter is added.

**Claim Objection**

Claim 1 is objected to for allegedly failing to provide antecedent basis for “the second protective element.” Specifically, it is alleged that “The second protection element was never recited” and “for purposes of examination it is assumed that ‘an integral protection element’ of the claim is the same as ‘second protection element’.”

Applicant refers the Examiner to line three of claim one which recites an integral “second protective element.” Thus, there is antecedent basis for the recitation of the “the second protective element” in line 4 of claim 1. Therefore, withdrawal of the objection is respectfully requested.

**Claim Rejections under 35 U.S.C. §103**

Claims 1, 6, 11 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,822,164 to Graf in view of US Patent 4,054,818 to Risberg. Claims 7, 8, 17 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Graf in view Riseberg and further in view of “current design practice.” The rejections are respectfully traversed.

Graf relates to a single-rated combination starter for controlling a ten horsepower motor in a three-phase 460 volt system. The starter includes an overload relay having current sensors, which do not carry motor current, a contactor and fuses sized for the motor. As shown in Fig. 1, the starter includes a mechanical disconnect switch DS, a fuse 6 installed between the disconnect switch DS and a contactor 4.

It is alleged in the Office Action that the switch DS corresponds to the claimed “second protective element” and the contactor 4 corresponds to the claimed “first protective element.” However, it is admitted in the Office Action that Graf fails to disclose or suggest, that the switch DS does not provide protection to an electronic switching element as claimed. In an effort to overcome the admitted deficiencies, it is alleged that it would have been obvious to one of

ordinary skill in the art at the time of the invention to modify the device of Graf by adding the semiconductor controlled rectifiers (SCR) 17, 18 of Riseberg.

Applicant respectfully submits that, even considering *arguendo* that it would have been obvious to so modify the starter of Graf, the combination of references still fails to disclose or suggest an integral second protective element in series with the first protective element and located on a line side of the first protective element, including a fuse, to provide short-circuit protection, wherein the second protective element is designed to provide overload protection for an electronic switching device, the electronic switching device being in series with the first protective element, and wherein the first protective element includes an overload relay in series with the second protective element.

For example, there is nothing in either of the applied references that would suggest to one of skill in the art to include the SCRs 17, 18 of Riseberg in series with the contactor 4 (alleged to correspond to the first protective element) of Graf.

Moreover, it is alleged in the Office Action that the overload relay 38 of Graf corresponds to the claimed "overload relay." However, the overload relay 38 of Graf is not in series with the switch DS (alleged to correspond to the claimed second protective element). Rather, in Graf, the overload relay 38 is only disclosed having contacts 38a connected in series with the coil 4d of contactor 4 (alleged to correspond to the first protective element).

As the combination of references fails to render the claims obvious, withdrawal of the rejection is respectfully requested.

Claims 5, 10, 15 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Graf in view of Riseberg and further in view of US Patent 6,853,289 to Scoggin. The rejection is respectfully traversed.

Claims 5, 10, 15 and 20 are allowable for their dependency on their respective base claims, as well as for the additional features recited therein. Therefore, withdrawal of the rejection is respectfully requested.

Claims 3, 4, 13 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Graf in view of Riseberg and further in view of US Patent 2,324,852 to Frank. The rejection is respectfully traversed.

Claims 3, 4, 13 and 14 are allowable for their dependency on their respective base claims, as well as for the additional features recited therein. Therefore, withdrawal of the rejection is respectfully requested.

Claims 9 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Graf in view of Riseberg and Frank. The rejection is respectfully traversed.

Claims 9 and 19 are allowable for their dependency on their respective base claims, as well as for the additional features recited therein. Therefore, withdrawal of the rejection is respectfully requested.

Claims 8 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Graf in view of Riseberg and further in view of JP 2001-126607 to Okamoto. The rejection is respectfully traversed.

Claims 8 and 18 are allowable for their dependency on their respective base claims, as well as for the additional features recited therein. Therefore, withdrawal of the rejection is respectfully requested.

### **CONCLUSION**

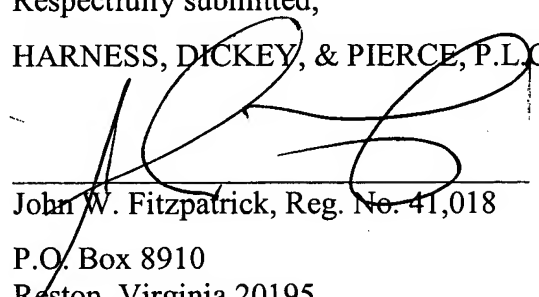
In view of the above remarks and amendments, Applicants respectfully submit that each of the rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Fitzpatrick at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,  
HARNES, DICKEY, & PIERCE, P.L.C.

By

  
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